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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/721,484

Filing Date: November 22, 2000

Appellant(s): MANOLIS ET AL.

Bao Tran
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/28/2005 appealing from the Office action mailed 9/9/2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Claimed Subject Matter*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Acknowledgement of the related Evidence Appendices

Applicant has acknowledged that the evidence appendix is not applicable.

(9) Acknowledgement of the related Proceeding

Applicant has acknowledged that the related proceedings appendix is not applicable.

(10) Evidence Relied Upon

6,321,211	Dodd	11-2001
6,263,317	Sharp	7/17/2001
6,629,079	Spiegel et al	9/30/2003

(11) Grounds of Rejections to be Reviewed

Drawings

The drawings filed on 11/24/2000 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Official Notice Traverse

A "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 31,32,34,35,36,37,51 and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Dodd (US 6,321,211).

In regards to claim 1, Dodd discloses a method for designating multiple recipients for an image at an on-line print service (FIG 1C, select recipient,

First, the examiner would like to define what is understood to be applicant's envelope. The applicant defines on page 10, line 2 that "An envelope is a virtual storage entity for holding images that are to be printed and delivered to a single destination". Microsoft Computer Dictionary defines a shopping cart as "a file in which an online customer stores information on potential purchases". Therefore the examiner considers the old and well known electronic shopping cart to be synonymous with the applicant's envelope (see also col 1, lines 26-44). the method comprising:

creating a plurality of envelopes and displaying each envelope on a user interface (FIG 1B and 1C);

associating with each envelope an intended recipient to receive images placed in a respective envelope (FIG 1C, card image).

displaying on the user interface one or more images along with the plural envelopes (FIG 1C, card images) ;

selecting an image for distribution to multiple recipients (FIG 1C); and
associating a selected image with two or more envelopes (FIG 1C).

In regards to claim 32, Dodd teaches displaying along with each envelope an identifier associated with the name of a recipient (col 4, lines 8-26, email address).

In regards to claim 34, Dodd teaches displaying a checkbox with each image, the checkbox for designating an image to be included in an order (FIG 1B, item 130).

In regards to claim 35, Dodd teaches wherein the step of associating an image includes placing an instance of the image in each envelope associated with an intended recipient (FIG 1B, a sample pictorial of the product).

In regards to claim 36, Dodd teaches an add button or link associated with each envelope, the add button, when invoked, operable to add a copy of each selected image to a respective envelope (FIG 1C, change button, and/or Figure 1B, item 130).

In regards to claim 37, Dodd teaches wherein the step of associating includes selecting an add button or link associated with an envelope of an intended recipient (FIG 1B).

In regards to claim 51, Dodd teaches processing all of the envelopes as a single order; and sending an email confirmation to user describing the order concomitant with the processing step (FIG 2A).

In regards to claim 52, Dodd teaches wherein the email confirmation includes a summary of each envelope (col 11, lines 18-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 33,38,39,40,53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd in view of Official Notice.

In regards to claim 33, Dodd teaches selecting items and placing the items in a shopping bag, but does not specifically mention that the shopping bag keeps a running total. It was old and well known in the art to include in shopping carts the use of a running total. It would have been obvious to a person having ordinary skill in the art to include in Dodd keeping a running total, because this would permit the user to keep track of how much they are spending and assure that they do not go over budget, thus improving the customers usability.

Furthermore, Dodd does not specifically mention that the product being placed in the shopping bag is a purchased image. It would have been an obvious matter of design choice to include the purchasing of images using the system of Dodd, because the applicant has not disclosed that limiting the purchasing system of Dodd to only purchasing images solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well selling images.

In regards to claim 38, Dodd teaches displaying price and quantity data associated with each envelope ((FIG 1B),

Dodd teaches selecting items and placing the items in a shopping bag, but does not specifically mention that the shopping bag keeps a running total or that the items once selected in Figure 1C show a total for the package to be purchased. It was old and well known in the art at the time of the invention to include in shopping carts the use of a running total and to give a final price for a selected package of goods or services. It would have been obvious to a person having ordinary skill in the art to include in Dodd keeping a running total and giving a configuration price, because this would permit the user to keep track of how much they were spending and permit the user to know how much the selection will cost.

, and

the quantity data including a count of a number of images included in the respective envelope (FIG 1B, item 135).

In regards to claim 39, Dodd teaches updating the price and the quantity data for a given envelope each time a new image is associated with a given envelope (see response to claim 1 and 38).

In regards to claim 40, Dodd teaches displaying an order total indicative of the price for processing all of the envelopes presented on the user interface. Dodd does not expressly point out that the method of Dodd is adding up multiple shopping carts on display, however the above discussion shows how the method does this for a single shopping cart. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to sum up the total for all the occasions shown in FIG 1C, since it has been held that mere duplication of essential working parts of a method involves only routine skill in the art. St Regis Paper Co. v. Bemis Co. 193 USPQ 8.

In regards to claim 53, Dodd teaches processing all of the envelopes in a single order; and displaying a status of the order when prompted by the user through the on-line print service (see response to claim 40 and FIG 2E).

In regards to claim 54, Dodd teaches processing all of the envelopes in a single order; aggregating summary information for each envelope on a single user interface page accessible by the user through the on-line print service. (see response to claim 40)

Claims 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd in view of Sharp (et al. (US 6,263,317).

In regards to claim 41, Dodd teaches making a purchase and a shopping bag, but does not mention that the system includes an order details button that summarized the purchases being made. Sharp teaches an order details button that can be used to present to the user a summary of a plurality of purchases (FIG 13). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Dodd the order details button as taught by Sharp, because this would give the user an opportunity to scan back to the order to decide if the configuration was correct and give another opportunity to reselect or delete from the order items that are not wanted, thus improving the shopping experience for the user. It should be noted that this is a common feature used in electronic shopping carts.

In regards to claim 42, Dodd teaches wherein the envelope summary includes a message to be printed on the print (FIG 2A, item 141).

In regards to claim 43, Dodd teaches wherein the envelope summary includes a preview of the print including as ordered including any user-designated effects (FIG 1C).

In regards to claim 44, Dodd teaches changing an order for an intended recipient when reviewing the envelope summary and automatically recalculating the price and quantity data displayed on the user interface for an associated envelope (see response to claim 41).

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd as in view of Spiegel et al (6,629,079).

In regards to claim 45, Dodd teaches ordering a plurality of products to multiple recipients (Claims 1A, 1B and 1C), but does not specifically state that an order button on the user interface along with the envelopes and image selections, the order button operable, when selected, to place an order in accordance with the envelopes specified on the user interface for plural recipients from a single user interface page. Spiegel

teaches an order button on the user interface along with the envelopes and image selections, the order button operable, when selected, to place an order in accordance with the envelopes specified on the user interface for plural recipients from a single user interface page (FIG 1). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Dodd the web page features as shown in Spiegel, because this would allow the user to complete the action without having to go to additional page, thus improving usability of the system.

Claims 46-50 and 55-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd in view of Sharp in view of Spiegel and further in view of Official Notice.

In regards to claim 46, Dodd teaches displaying an order summary in a single summary user interface for plural recipients, the order summary including plural entries, one for each envelope specified in the user interface (see response to claims 40 and 41).

In regards to claim 47, As previously discussed the combination of Dodd/Sharp/Spiegel/Official Notice teaches listing items on a single page and totaling a price, but this combination does not specifically mention that the price includes cost for selected shipping expenses. It was old and well known in the art at the time of the invention to add any number of costs to a final shipping invoice, including costs associated with shipping, which can vary considerably on the needed time for delivery (overnight), distance, country, quantity or weight to be shipped. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Dodd/Sharp/Spiegel/Official Notice the further cost of shipping or any other extraneous cost, because these costs may sometimes be more than the part itself, therefore the company could potentially loose money if these costs were not included in the final total to the customer.

In regards to claim 48, Dodd teaches displaying quantity data and price data on the order summary for each envelope (see response to claim 39).

In regards to claim 49, Dodd teaches displaying a pay now button, that when invoked, is operable to process all of the envelopes specified in the order summary (Spiegel, FIG 1).

In regards to claim 50, Dodd teaches processing of the order, however, the combination of Dodd/Sharp/Spiegel/Official Notice does not expressly point out that the method of Dodd is adding up multiple shopping carts on display. The above discussion shows how the method of Dodd processes an order for a single shopping cart. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to sum up the total for all the occasions shown in FIG 1C, since it has been

held that mere duplication of essential working parts of a method involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.* 193 USPQ 8.

In regards to claims 55 through 64, these claims have similar features of claims 31-54 treated above and are therefore rejected for the reasons stated above, with the exception that claims 55-64 have the additional features of sharing images and later making a purchase based on the received image. Dodd teaches these additional features of sharing an image (FIG 2E and 2F) and also teaches purchasing based on the received image (FIG 5).

(12) Response to Argument

In response to appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., allow the user selecting one or more pictures into one or more envelopes for printing) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that Dodd fails to show "creating a plurality of envelopes and displaying each envelop on a user interface". The examiner disagrees; FIG 1C clearly shows multiple shopping bags (envelops) displayed on a user interface (see occasion).

Appellant argues that Dodd does not teach, "associating a selected image with two or more envelops". The examiner disagrees noting that clearly when a buyer selects the same gift or card for different recipients from the "top ten gift list" or "favorite gift list"

the same gift/product ("image" is the gift/product that the instant application is forwarding), is associated with multiple shopping bags (envelopes).

Appellant argues that Dodd can receive only one item at a time. The examiner disagrees and directs the appellant's attention to FIG 1B, item 135, Quantity.

Appellant argues that FIG 1C does not show multiple shopping bags (envelopes). The examiner disagrees and notes that each displayed event is a separate occasion that has a separate envelope associated with the occasion.

Appellant argues that Dodd does not teach selecting an image for distribution to multiple recipients. The examiner disagrees and directs the appellant's attention to FIG 1C, specifically "My Favorite Gifts" which expressly implies that the same gift is being selected for multiple recipients.

Applicant argues that Dodd fails to show "associating a selected image with two or more recipients. The examiner disagrees and directs the appellant's attention to FIG 1C, specifically "My Favorite Gifts" which expressly implies that the same gift is being selected for multiple recipients.

In regards to claims 32 and 52, appellant argues that Dodd only shows one shopping cart. The examiner disagrees and directs the applicant's attention to Fig 1C

which clearly shows three different shopping carts Birthday, Valentines day and Mothers day. Further, as discussed in claim 40, mere duplication of essential working parts of a method involves only routine skill in the art, *St. Regis Paper v Bemis Co.* USPQ 8. Furthermore, it is shown on FIG 5 that the system stores order information in a gift queue (item 520), expressly implying that multiple gift selections to a plurality of recipients are kept.

In regards to claims 33-37 and 51 appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patently distinguishes them from the references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has provided motivation for each of the combinations as can be found in the prior office action.

In regards to claims 42-44 appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The examiner maintains the rejection in the prior office action.

In response to applicant's arguments against the references individually, in the arguments presented for claim 45, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In regards to claims 46-50 and 55-64, the examiner maintains the Official Notice rejections as stated in the previous rejection of the instant claims.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Mark Fadok
Primary Examiner

January 25, 2006

Conferees

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